UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/718,885 | 11/21/2003 | Gary A. Hoberman | 37799-00200 | 1487 |

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| EXAMINER |
|---|
| CHAVIS, JOHN Q |

| ART UNIT | PAPER NUMBER |
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| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *2/2/07*.

2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-26* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All  b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *Corrected 3/31/05*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

U.S. Patent and Trademark Office

## *Claim Rejections - 35 USC § 101*

1.       35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.       The claimed invention is directed to non-statutory subject matter. The claimed

invention in claims **10**, 11, **12, 22, 23** are non-statutory; since, it is claimed as

transmitted code **(see specifically claims 11 and 22)**. Patentable subject matter of this

type would be stored on a computer **storage** ~~readable~~ medium (a manufactured item,

**such as claim 23**), a method (process) comprising specific computer implemented

steps or a means for executing (machine) the specific steps of each method. The

claimed "transmitted code" **(specified in claims 11 and 22)** is not considered to fit into

either of the statutory classed indicated above. **Furthermore, claim 10 claims a**

**system; however, nothing in the claim appears to indicate a specific hardware**

**component of a system. The applicant claims various means; however, nothing in**

**the claims indicate that the claims are anything other than software. Claim 10 can**

**be fixed by adding "a processor with" after "comprising" on line 2.**

**Claims 12 and 23, on the surface, appear to be statutory; however, it is not**

**clear that the applicant's computer readable medium is anything other than his**

**intended "transmission media" (utilized for software code transmitted as an**

**information signal).** Therefore, the claims are non-statutory.

**The current focus of the Patent Office in regard to statutory inventions under 35**

**U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that**

**the claimed invention recite a practical application. Practical application can be provided**

by a physical transformation or a useful, concrete and tangible result. No physical

transformation is recited and additionally, the final result of claims 11 and 22 is the

transmission of code, claim 10 is considered a system of software components and claims 12

and 23 are considered a computer readable medium that does not exclude a transmission

medium, which are not a tangible result because the code alone in claims 11 and 22 is non

functional and not stored on a computer storage medium. Claims 12 and 23 also consists of

code and is not stored on a computer storage medium and the system of claim 10 is

considered merely software means that is not specifically tied to components of a computer

system.


## *Claim Rejections - 35 USC § 102*

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.      Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Rodrigues et al. (6,067,639).

| <u>Claims</u> | <u>Rodrigues</u> |
|---|---|
| 1. A method for software application development, the method comprising: characterizing the file format and data structure of at least one known input file type; and | See the title, abstract and col. 3 lines 25-29. |
| creating a library comprising a plurality of jobs, | See col. 3 lines 29-35. |

each job configured to perform a predetermined function and each job including an indicator of job termination, wherein the indicator is either termination success or termination failure, and

See col. 3 lines 51-65 and col. 2 lines 4-11.

the plurality of jobs are configured for linking according to the indicator, with at least one of the jobs configured to read the file format and data structure of the known input file

"          "        "         "

and convert that input file to another file format or data structure...

See col. 4 lines 16-36, **which specifically addresses porting to different environments (i.e converting). Rodrigues indicates that** "The test tools can be readily available in any computing environment to which the development staff chooses to port the application program. In addition, the test tools of the present invention, unlike scripting and macro methods of the past, do not require the development or testing teams to port the test cases between the various computing environments on which the program is to be tested. The test tools of the present invention are available for all platforms on which the application program may be run. The test suites are recorded in a portable manner by the test tools of the present invention in so-called playback files, see also lines 37-44 of col. 4.

**The applicant indicates that he finds no conversions performed by Rodrigues; however, the abstract indicates that it provides for "simulating" required data or file, which provides for converting, see any standard dictionary. Note also the problem of communicating in different environments that Rodrigues addresses via col. 2 lines 12-30**

**The feature of converting to a substantially common format is considered the main reason for performing conversions to enable compatibility and this feature is considered inherent in Rodrigues' system to enable porting of cases between various environments.**

2. A method according to claim 1, wherein the library of jobs comprise at least one job configured for extracting data from a file.

See col. 3 line 33-39.

3. A method according to claim 1, wherein the library of jobs comprise at least one job configured for archiving files.

See col. 4 lines 27-33.

4. A method according to claim 1, wherein the library of jobs comprise at least one job configured for loading files.

See col. 9 lines 26-31.

5. A method according to claim 1, wherein the library of jobs comprise at least one job configured for messaging.

See col. 13 lines 37-45, col. 14 lines 15-19, col. 14 lines 35-40 and col. 17 lines 53-64.

6. A method according to claim 1, wherein the library of jobs comprise at least one job configured for transforming data in a file.

See the information above and col. 9 lines 18-28.

7. A method according to claim 1, wherein the library of jobs comprise at least one job configured for validating data in a file.

See col. 6 lines 10-19.

8. A method according to claim 1, further comprising: creating a job stream library, the job stream library comprising at least one job

See the rejections above.

stream, the job stream comprising
individual jobs from the library of
jobs, and the at least one job stream
in the job stream library including
an indicator of job termination,
wherein the indicator is either
termination success or termination
failure.

9. A method according to claim 1,                    See claim 12 of '639.
further comprising adding jobs to
the library of jobs.

Claims 10-14 are rejected as claim 1. **The applicant claims that claim 14 is**

**about processing; however, the actual features (specifically in claim 14) contain**

**no more processing than specified in claims 21-24. The applicant should note**

**that when significant differences are enabled by the claims, restriction is proper.**

### Claim Rejections - 35 USC § 103

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.      Claim 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rodrigues in view of the applicant's choice of selecting the delivery method of data.

While Rodrigues does not specifically mention receiving the data file as an email

attachment (although he provides for porting to different environments), the feature is

considered a choice of design and merely a selection not related to the development of

the software application. Claims 16-17 are rejected for the same reason specified in the rejection of claim 15 above. Rodrigues also does not provide for checking security access, as indicated in claim 18; however, the feature would have been obvious to a person having ordinary skill in the art at the time of the invention to ensure the files are transmitted to authorized users.

Rodrigues also does not teach the feature of utilizing a visual interlinking of jobs (claim 19); however, the feature would have been obvious to a person having ordinary skill in the art at the time of the invention to show the user how jobs are linked to simplify the development process and enable easy modification of existing processes. Rodrigues also does not indicate that a specific programming language (claim 20) is utilized; however, it would have been obvious to a person of ordinary skill in the art at the time of the invention that some programming language has to be used and to merely select a specific programming language to take advantage of its specific features, such as ease of use, compatible with most systems and simplifying the process of transmitting to other systems (such as via email).

Rodrigues teach each of the features of claims 21-24 except the manager feature; however, in the following locations certain management functions exist, see col. 4 lines 45-51 and col. 6 lines 53-67 and col. 15 lines 47-51. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enable management functions to be created along with the developed software to ensure compatibility and to enable control and testing of the specific functions created during development.

**In reference to claims 25-26, the type of file selected for use is also considered a choice of design; since the choice selected does not modify the method steps to create a new method.**

7.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Chavis whose telephone number is (571) 272-3720.  The examiner can normally be reached on M-F, 9:00am-5:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An  can be reached on (571) 272-3756.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.  Status information for published applications may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished applications is available through Private PAIR only.  For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC

John Chavis
Primary Examiner AU-2193